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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,666	04/04/2006	Mannalal Ramgopal Bajaj	125139-00101	9001
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BLANK ROME LLP WATERGATE 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037			EXAMINER LEA, CHRISTOPHER RAYMOND	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,666	Applicant(s) BAJAJ ET AL.	
	Examiner Christopher R. Lea	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7,9,10,12 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7,9,10,12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application is a 371 (national stage application) of PCT/IN04/00342.

Receipt of Amendments/Remarks filed on December 15, 2009, is acknowledged.

In response to Non-final office action dated September 15, 2009, applicant amended claim 7, canceled claim 8, and added no new claims. Claims 1, 7, 9, 10, 12, & 16-18 are pending. Claims 1, 7, 9, 10, 12, & 16-18 are under examination.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 7, 9, 10, 12, & 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Upon additional consideration by the examiner, it has been determined that the concept of a rabeprazole to alkaline compound ratio being about 1:0.359 in claim 1 (and claim 18) is not

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supported by the original disclosure of the application, and as such is new matter. Applicant have previously stated that support for this amendment to claim 1 is found in original claim 5 and table on page 7 of the specification (see Remarks dated 4/13/2009). It can be unequivocally stated that original claim 5 contains no support for a ratio, be it implicit, explicit or inherent. Therefore, the support for the ratio must come from the table. While the ratio of rabeprazole sodium to sodium hydroxide in the first column of the table can be computed to be 1:0.359, such does not reasonably convey to one of ordinary skill in the art that applicant was in possession of the invention of claim 1. First, the table specifically uses sodium hydroxide, which is not commensurate in scope with the "alkaline compounds". Also, the table provides the exact value, so the support for "about" 1:0.359 is not explicit. Most crucially though, the specification as a whole does not lead one of ordinary skill in the art to conclude that applicant recognized the criticality of this ratio. Nowhere in the specification is the ratio of rabeprazole to alkaline compound mentioned. In fact, the specification recognizes that critical variable for stability of benzimidazole compounds is the pH (page 6, 3rd paragraph). Even the column of the table which generates the ratio limitation states that the amount of sodium hydroxide was used to adjust the pH. Based on a preponderance of this evidence, the concept of a set ratio of rabeprazole to alkaline compound is not adequately supported by the original disclosure to reasonably convey to one of ordinary skill in the art that applicant was in possession of such subject matter at the time of invention.

Since claims 7, 9, 10, 12, 16, & 17 are dependent from claim 1, they are also rejected under 35 U.S.C. § 112, first paragraph.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 1, 7, 9, 10, 12, & 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doen et al. (US PreGrant Publication 2003/0191157) in view of Nakanishi et al. (US Patent 5,589,491).

Applicant claims

Applicant claims a drug delivery system containing rabeprazole sodium, mannitol, an alkaline compound and water for injection. Applicant further teaches a method of making such a system.

Determination of the scope and content of the prior art (MPEP 2141.01)

Doen et al. teach, as a whole, an injectable composition containing a benzimidazole.

Claims 1 & 7: Doen et al. teach an injectable composition containing a benzimidazole compound and an alkaline compound in a molar ratio of about 1:1 (paragraph 35). Doen et al. teach rabeprazole sodium among the benzimidazole compounds suitable for use in the injectable composition (paragraph 76). Doen et al. teach that sodium hydroxide is the preferred alkaline compound suitable for use in the injectable composition (paragraph 86). Doen et al. teach that a saccharide may be added to the composition as an excipient and that mannitol is the preferred excipient suitable for use in the injectable composition (paragraph 91). Doen et al. teach water for injection as a solvent for dissolving (paragraph 99) or redissolving (paragraph 110) the composition. Doen et al. teach the pH of the composition as about 9 to 11 in physiological saline (paragraph 99).

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Claims 9 & 16: Doen et al. teach a composition that contains ~29% benzimidazole compound (Example 3, Table 4, paragraph 132).

Claims 10 & 17: Doen et al. teach a composition that contains ~58% excipient (Example 3, Table 4, paragraph 132).

Claims 18 & 12: Doen et al. teach adding a benzimidazole compound and mannitol to a sodium hydroxide solution and adding water for injection (paragraph 128, changing the order of adding ingredients is *prima facie* obvious, MPEP § 2144.04.IV.C). Doen et al. teach rabeprazole sodium among the benzimidazole compounds suitable for use in the injectable composition (paragraph 76). Doen et al. teach sterile filtering the solution (through 0.22 micron filter) and placing it in vials (paragraphs 128-9). Though Doen et al. are silent as to the exact size of the vial and its sterility, they teach the vial size is under 20 mL (paragraph 106) and it would have been obvious to a skilled artisan to put a sterile filtered solution into a sterile vial and bunging the vial to maintain sterility. Doen et al. are silent as to the temperature at which the steps are carried out; however, the maintaining a constant temperature is within the purview of the skilled artisan. Doen et al. teach lyophilizing the solution to form a powder (paragraph 132). The resultant composition meets the limitations of claim 12.

**Ascertainment of the difference between the prior art and the claims
(MPEP 2141.02)**

The difference between the teachings of Doen et al. and the instant claims is that Doen et al. do not exemplify an embodiment of the invention using rabeprazole sodium

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in the claimed molar ratio. This deficiency in Doen et al. is cured by the teachings of Nakanishi et al.

Nakanishi et al. teaches, as a whole, injectable formulations of benzimidazole compounds (abstract).

Nakanishi et al. teaches an injectable formulation containing water for injection, sodium hydroxide and omeprazole (a benzimidazole of the same family possessing similar proton pump inhibiting activity) with a pH of 11.5 where the ratio of benzimidazole active agent to alkaline agent is 1:0.0397 (example 1, table 4).

**Finding of *prima facie* obviousness
Rationale and Motivation (MPEP 2142-2143)**

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to use rabeprazole sodium as the benzimidazole and adjust the molar ratio of alkaline to rabeprazole sodium and produce the instant invention. The skilled artisan would have been motivated to use rabeprazole sodium as the benzimidazole because Doen et al. teach that it is suitable for that use and it is within purview of the skilled artisan to select a known material based on its suitability for its intended use. Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle (see MPEP § 2144.07). The skilled artisan would have been motivated to adjust the ratio of rabeprazole sodium to alkaline compound because Doen et al. although the preferred ratio is 1:1, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is

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evidence indicating such concentration is critical. It is not inventive to discover the optimum or workable ranges by routine experimentation when the prior art discloses the general conditions of a claim (See MPEP 2144.05 II). Further, the teachings of Nakanishi et al. clearly demonstrate that a ratio lower than 1:1 is not only feasible, but has a high expectation of success.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in using rabeprazole sodium as the benzimidazole and adjusting the molar ratio of alkaline to rabeprazole sodium and producing the claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

In light of the forgoing discussion, one of ordinary skill in the art would have concluded that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

Response to Arguments

3. Applicant's arguments filed December 15, 2009, have been fully considered but they are not persuasive. Applicant argues that the declaration of Mr. Shah establishes unexpected results.

The declaration under 37 CFR 1.132 filed December 15, 2009, is insufficient to overcome the rejection of claims 1, 7, 9, 10, 12, & 16-18 based upon Doen et al. applied

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under 35 U.S.C. 103 as set forth in the last Office action because: The declaration fails to be convincing on several fronts. First, It is not clear that the comparison of the two samples is a true side-by-side comparison of the prior art and claimed compositions. Applicant does not clearly identify the components or component percentages of the two samples. The terms "other ingredients" and "alkaline compound" do not clearly convey that the two samples are comparable. Second, this omission prevents the examiner from establishing that the composition is commensurate in scope with the claims, i.e. there is no mention of mannitol, a component required by claim 1. Third, the results themselves do not appear to be of statistical relevance. The evidence relied upon should establish "that the differences in results are in fact unexpected and unobvious and of both *statistical and practical* significance." (emphasis added, See MPEP 714.02(b) I). The declaration shows that the rabeprazole in the A sample goes from 100.9% to 98.6% (2.3% decrease) and in the B sample goes from 97.6% to 91% (6.6% decrease) after 1 hour following reconstitution. No description of the method for the determination of these percentages is described, so it is unclear whether the differences are within the limits of detection and quantification for the assay (i.e. its sensitivity). Without such information one of ordinary skill in the art would not be able to determine if the differences shown are differences of degree or kind. Further, since both samples are within the desired specification and injection usually occurs in a shorter time period than one hour after reconstitution, it is unclear just how much this added "stability" is really practically beneficial. Assuming *arguendo* that the evidence had shown an unexpected property, "[w]here the unexpected properties of a claimed

invention are not shown to have a significance equal to or greater than the expected properties, the evidence of unexpected properties may not be sufficient to rebut the evidence of obviousness." (See MPEP § 716.02(c) I).

The expected result remains the same; an injectable formulation of rabeprazole is made in the absence of evidence to the contrary. No unexpected results have been presented. Applicant's arguments are not persuasive; and the rejection under 35 U.S.C. §103(a) is maintained.

Conclusion

Claims 1, 7, 9, 10, 12, & 16-18 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Lea whose telephone number is (571) 270-5870. The examiner can normally be reached on Mon-Fri 8:00-4:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne "Bonnie" Eyler can be reached on (571)272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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CRL